

REMARKS

This amendment is in response to the Office Action dated June 8, 2009. After its entry, claims 1-12, 14-22, and 24-33 are currently pending in this application and subject to examination. Claims 1-12, 14-22, and 24-33 are amended. Support for the amendment to claim 1 is found on page 9, lines 26-30, of the present specification. Claims 2-12, 14-22, and 24-33 are amended so that they better conform to standard United States claim practice and to correct minor errors. No new matter is added.

Reconsideration of the application as amended is respectfully requested in view of the following remarks.

Rejection Under 35 U.S.C. § 103(a)

Claims 1-3, 6-12, 14, 18-22, 24-27, and 30-33 stand rejected as obvious over U.S. Patent No. 6,544,607 to Kuroki et al. (Kuroki). Claims 4, 5, 15-17, 28, and 29 stand rejected as obvious over Kuroki in view of U.S. Patent No. 4,818,782 to Bissot (Bissot). Applicants respectfully traverse in view of the amended claims.

Rejection over Kuroki

Applicants maintain that claims 1-3, 6-12, 14, 18-22, 24-27, and 30-33, as amended, are non-obvious over Kuroki for the reasons submitted in the amendment filed March 1, 2009, which is incorporated by reference herein in its entirety. Applicants submit that claims 1-3, 6-12, 14, 18-22, 24-27, and 30-33, as amended, are also non-obvious over Kuroki for the following reasons.

The Examiner asserts that Kuroki discloses (1) a multiple layer biaxially oriented film comprising a "base layer" that is a polyester composition comprising aliphatic hydroxycarboxylic acid, glycerin fatty esters, and mica, and (2) that an antistatic layer may be formed on both surfaces of this "base layer," such that the bottom antistatic layer can be treated as the "base layer" and the original "base layer" can be treated as the "covering layer."

However, Kuroki neither teaches nor suggests that this antistatic layer, nor any of the other functional layers disclosed at column 8, line 57, to column 9, line 12, of Kuroki, comprises at least one polymer of at least one aliphatic hydroxycarboxylic acid. In contrast, independent claims 1, 18, and 26, as amended, all require that the base layer recited therein comprise at least one polymer of at least one aliphatic hydroxycarboxylic acid. To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. MPEP 2143.03, citing *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Since Kuroki neither teaches nor suggests a “base layer,” as postulated by the Examiner, comprising at least one polymer of at least one aliphatic hydroxycarboxylic acid, it cannot teach or suggest all of the limitations of independent claims 1, 18, and 26. Therefore, Kuroki cannot render these claims *prima facie* obvious. Furthermore, since claims 2, 3, 6-12, 14, 19-22, 24, 25, 27, and 30-33 all ultimately depend from one of claims 1 and 18, these dependent claims likewise cannot be rendered *prima facie* obvious by Kuroki. Applicants respectfully request withdrawal of this rejection.

Rejection over Kuroki in view of Bissot

Applicants maintain that claims 4, 5, 15-17, 28, and 29, as amended, are non-obvious over Kuroki in view of Bissot for the reasons submitted in the amendment filed March 1, 2009, which is incorporated by reference herein in its entirety. Applicants submit that claims 4, 5, 15-17, 28, and 29, as amended, are also non-obvious over Kuroki in view of Bissot for the following reasons.

As discussed *supra*, Kuroki neither teaches nor suggests a “base layer,” as postulated by the Examiner, comprising at least one polymer of at least one aliphatic hydroxycarboxylic acid. Bissot also fails to teach or suggest such a base layer and fails to suggest incorporating a polymer of at least one aliphatic hydroxycarboxylic acid into functional layers, such as those disclosed by Kuroki. Therefore, the combined disclosures of these references do not teach or suggest all of the limitations of independent claim 1 and, thus, cannot render this claim *prima facie* obvious. Consequently, since claims 4, 5, 15-17, 28, and 29 all ultimately depend from claim 1, these

dependent claims likewise cannot be rendered *prima facie* obvious by the combined disclosures of Kuroki and Bissot. Applicants respectfully request withdrawal of this rejection.

In view of the foregoing amendment and remarks, Applicants submit that the pending application is in condition for allowance.

Payment in the amount of \$940.00 to cover the fees required by 37 C.F.R. §§ 1.17(a)(1) and 1.17(e) for a one-month extension of time and a Request for Continued Examination is submitted concurrently herewith. Should any other fees be required in connection with this amendment, the Director is hereby authorized to charge any fees due or outstanding, including any extension fees, or credit any overpayment, to Deposit Account No. 03-2775, under Order No. 05581-00147-US, from which the undersigned is authorized to draw.

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Respectfully submitted,

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